

filed in this or a separate application(s). A copy of the claims as currently pending after the amendments herein is provided as Appendix A.

Status of Office Action

On page 4 of the Office Action, the Examiner states that the Office Action is final, although the Office Action Summary (PTO Form 326) does not indicate that the Office Action is final. In a telephone conference on November 22, 2000, Examiner Schmidt confirmed that this Office Action is non-final, and thus this response is being submitted as a response to a non-final Office Action.

Rejection of Claim 23 under 35 U.S.C. §112, second paragraph

Claim 23 was rejected under 35 U.S.C. §112, second paragraph, based on recitation of the claim language "capable of." Applicants submit that this rejection does not pertain to claim 23 as currently pending. Claim 23 has been amended to recite that the inactive RNA molecule "binds to" the target molecule. The claim as currently pending does not recite "capable of." Accordingly, Applicants respectfully request that this rejection be withdrawn.

Rejection of Claim 23 under 35 U.S.C. §102(a)

Claim 23 was rejected under 35 U.S.C. §102(a) as being anticipated by Kramer et al. (U.S. Patent No. 5,616,459). Applicants respectfully traverse this rejection and submit that it does not pertain to claim 23 as currently pending. Claim 23 is directed to a method for detecting the presence of a target molecule in a composition suspected of containing the target molecule, the method involving:

contacting the composition with a catalytically inactive RNA molecule which binds to the target molecule, wherein binding of the catalytically inactive RNA molecule to the target molecule allows the catalytically inactive RNA molecule to become catalytically active towards a substrate other than the target molecule,

wherein the action of the catalytically active RNA molecule on the substrate is indicative of the presence of the target molecule in the composition.

For a reference to anticipate the claimed invention, the reference must teach each and every element of the claimed invention. Kramer et al. do not disclose a method in which binding of a catalytically inactive RNA molecule to a target molecule allows the catalytically inactive RNA molecule to become catalytically active towards a substrate other than the target molecule. Furthermore, Kramer et al. do not disclose a method in which the action of the catalytically active RNA molecule on the substrate is indicative of the presence of the target molecule in the composition. Since Kramer et al. do not teach each and every element of the claimed invention, this reference does not anticipate the claimed invention. Accordingly, Applicants respectfully request that this rejection be withdrawn.

Rejection of Claim 23 under 35 U.S.C. §102(b)

Claim 23 was rejected under 35 U.S.C. §102(b) as being anticipated by Draper et al. (U.S. Patent No. 5,496,698). Applicants respectfully traverse this rejection and submit that it does not pertain to claim 23 as currently pending. Claim 23 is directed to a method for detecting the presence of a target molecule in a composition suspected of containing the target molecule, the method involving:

contacting the composition with a catalytically inactive RNA molecule which binds to the target molecule, wherein binding of the catalytically inactive RNA molecule to the target molecule allows the catalytically inactive RNA molecule to become catalytically active towards a substrate other than the target molecule,

wherein the action of the catalytically active RNA molecule on the substrate is indicative of the presence of the target molecule in the composition.

For a reference to anticipate the claimed invention, the reference must teach each and every element of the claimed invention. Draper et al. do not disclose a method in which binding of a catalytically inactive RNA molecule to a target molecule allows the catalytically inactive

RNA molecule to become catalytically active towards a substrate other than the target molecule. Furthermore, Draper et al. do not disclose a method in which the action of the catalytically active RNA molecule on the substrate is indicative of the presence of the target molecule in the composition. Since Draper et al. do not teach each and every element of the claimed invention, this reference does not anticipate the claimed invention. Accordingly, Applicants respectfully request that this rejection be withdrawn.

CONCLUSION

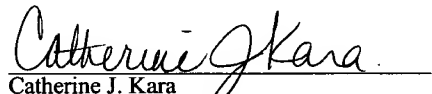
Applicants respectfully submit that all claims are in condition for allowance. If a telephone conference with Applicants' attorney would be of assistance, the Examiner is urged to call the undersigned at (650) 813-5756.

In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, applicants petition for any required relief including extensions of time and authorize the Assistant Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket no. 367592000100. However, the Assistant Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Respectfully submitted,

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APPENDIX A

23. (Amended) A method for detecting the presence of a target molecule in a composition suspected of containing said target molecule, said method comprising:

contacting said composition with a catalytically inactive RNA molecule which binds to said target molecule, wherein binding of said catalytically inactive RNA molecule to said target molecule allows said catalytically inactive RNA molecule to become catalytically active towards a substrate other than the target molecule,

wherein the action of the catalytically active RNA molecule on the substrate is indicative of the presence of said target molecule in said composition.